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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
10/829,640	04/22/2004	James E. Swon	04-02 US	7024								
23693 Varian Inc. Legal Department 3120 Hansen Way D-102 Palo Alto, CA 94304	7590 08/07/2007		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">HANDY, DWAYNE K</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1743</td><td></td></tr></table>		EXAMINER		HANDY, DWAYNE K		ART UNIT	PAPER NUMBER	1743	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,640	Applicant(s) SWON ET AL.	
	Examiner Dwayne K. Handy	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 44-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah (3,801,280). This rejection was previously applied to claims 1-5, 7-13, 15, 16, 18-23 and 25 in Paragraph 4 of the Office Action mailed 3/8/07. It now applies to new claims 44-63. Please see Response to Arguments below.

3. Claims 44-46 and 49-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuellig et al. (6,126,904). This rejection was previously applied to claims 1-17, 21 and 23-43 in Paragraph 5 of the Office Action mailed 3/8/07. It now applies to new claims 44-46 and 49-63. Please see Response to Arguments below.

Response to Arguments

4. The Examiner has removed the previous rejection under Nielsen in response to Applicant's arguments submitted 5/17/07.

5. Applicant has argued that none of the remaining references teach non-contacting actuation of sample carriers. The Examiner respectfully disagrees and

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submits that Applicant's Arguments are beyond the scope of the claim as written. Claim 44 now broadly recites a means for supporting a sample carrier and a drivable component attached to the sample carrier. The drivable component may include an element that can be actuated from outside the container.

(A) Zuellig

The Examiner notes that "sample carrier" is a broad term that is defined by function and not structure. Applicant has not claimed an element defined by its structure. Therefore, anything that may carry a sample would meet this limitation. A capsule or gel or even a simple liquid/solid mixture that contains a sample would be a "sample carrier". The element that receives the capsule of gel or mixture would be a "sample carrier supporting means". In the case of Zuellig, the Examiner considers the agitation element (#35) to be a "sample carrier support means" having a "drivable component" attached to it. The agitator element is comprised of a drivable inner portion - a magnetic or ferrous plunger, stir bar, bar, bead, column or disk (column 7, lines 63-65) and an outer portion that can support a sample carrier - an inert material having surface modifications such as grooves dimples and vanes (Figure 1C, column 8, lines 8-22). The outer portion is capable of receiving a sample carrier in the forms mentioned above - whether as a coating of the simple solid mixture or by placing a capsule between the fins of one of the agitation embodiments. When the inner magnetic portion is driven by the externally position magnet (500), the outer portion moves as well. Therefore, when agitation element (#35) is actuated, it moves a driving component and

a sample carrier supporting means together, as required by claim 44. In claim 46, Applicant adds broadly claimed first and second "support members" for the "sample carrier supporting means". The Examiner considers the fins shown on the bottom example from Figure 1C as meeting this limitation.

(B) Shah

The Examiner again notes that "sample carrier" is a broad term that is defined by function and not structure. Applicant has not claimed an element defined by its structure. Therefore, anything that may carry a sample would meet this limitation. A capsule or gel that contains a sample would be a "sample carrier". The element that receives the capsule or gel or mixture would be a "sample carrier supporting means". In the case of Shah, the Examiner considers the filter element (#8) to be a "sample carrier support means" having a "drivable component" attached to it. It may be considered a "sample carrier support means" because it may contain a capsule or gel within the area inside the filter. It has a drivable component comprised of the magnet (16) in the base (9) portion. The Examiner considers the base (9) and top (11) portions to be first and second "support members". They may be adjusted by changing the level of compression applied to the cushion member (23) or sealing ring (18).

6. Applicant has argued that the previously submitted replies have pointed out the meaning of "sample carrier" and "means for supporting a sample carrier" (page 8, lines 9-13). Applicant's arguments, however, are directed to a structure that goes beyond the

structure which is conferred by giving those terms their broadest meaning as is required by the Examiner. That is, given Applicant's use of functional language, the Examiner need not find the structural element being argued by Applicant when the element is claimed as a functional limitation. If the element cited by the Examiner is capable of meeting the claimed function, then that element anticipates the claimed element. The Examiner suggests adding at least some minimal physical structure to the "sample carrier" and "sample carrier supporting means" elements of the claim(s). As the claim is currently written with broad, functional limitations, the Examiner fails to see how Applicant's device is distinguished from any apparatus that simply has a container with an element having an embedded or attached magnet as long as the magnet can be moved in a fashion that moves the magnet and the element has hold a solid gel or be coated. These elements are capable of meeting the broadly defined functional limitations of the claim.

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
August 6, 2007


Jill Warden
Supervisory Patent Examiner
Technology Center 1700